



#23

D-1108

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	
David T. Frederick	)	
Serial No.: 09/288,685	)	Art Unit: 3653
Confirmation No.: 7773	)	
Filed: April 9, 1999	)	Patent Examiner:
	)	Jeffrey Shapiro
Title: Medical Cabinet With	)	
Adjustable Drawers	)	

Board of Patent Appeals and Interferences  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

SUPPLEMENTAL BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 1.192

Sir:

The Appellant hereby respectfully requests reinstatement of the appeal pursuant to 37 C.F.R. § 1.193(b)(2). The Appellant hereby submits the Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application.

RECEIVED  
MAY 16 2003  
OFFICE OF PETITIONS

## **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is MedSelect, Inc., a Delaware corporation.

## **RELATED APPEALS AND INTERFERENCES**

Appellant believes that there are no related appeals or interferences pertaining to this matter.

## **STATUS OF CLAIMS**

Claims 1-56 are pending in the Application.

Claims 1-56 were rejected pursuant to 35 U.S.C. § 112, second paragraph.

Claims 1-19, 29-36, 40-48, and 53-56 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Bach.

Claims 20-28 and 37-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lipps in view of Bach et al.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent 5,961,036 in view of Bach et al.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent 6,073,843 in view of Bach et al.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent 5,957,372 in view of Bach et al.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent 5,790,409 in view of Bach et al.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of U.S. Patent 6,163,737 in view of Bach et al.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent 5,404,384 in view of Bach et al.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent 5,533,079 in view of Bach et al.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent 5,971,593 in view of Bach et al.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent 5,993,046 in view of Bach et al.

These rejections were the only rejections present in the Office Action ("Action") dated July 11, 2002. Appellant appeals the rejection of claims 1 through 56, inclusive.

## **STATUS OF AMENDMENTS**

A final rejection was made July 11, 2002. No amendments to the claims were requested to be admitted after the final rejection. However, a Petition to Review a Decision of a Technology Director has been filed herewith.

### Overview of dates and papers associated with this application

- |    |          |  |
|----|----------|--|
| 1. | 04/09/99 | Initial filing   |
| 2. | 08/17/00 | Office Action (first) rejection  |
| 3. | 11/10/00 | Response by Appellant (successfully traversing the rejection)          |
| 4. | 02/12/01 | Office Action, first restriction requirement                           |
| 5. | 03/01/01 | Response by Appellant (successfully traversing the first restriction)  |
| 6. | 05/22/01 | Office Action, second (different) restriction requirement              |
| 7. | 06/04/01 | Response by Appellant (successfully traversing the second restriction) |
| 8. | 07/17/01 | Office Action (second non final) rejection                             |
| 9. | 10/17/01 | Notice of Appeal   |

10. 12/17/01 Appeal Brief
11. 03/05/02 Notice of defective Appeal Brief
12. 03/14/02 Resubmitted Appeal Brief
13. 05/03/02 Petition to Withdrawal Holding of Noncompliance
14. 07/11/02 Notice of defective Appeal Brief
15. 08/28/02 Petition to Withdrawal Holding of Noncompliance
16. 03/21/03 Decision on Petitions

## **SUMMARY OF INVENTION**

### Overview of the Invention

An exemplary embodiment of the present invention is directed to a medical item storage cabinet. The cabinet has adjustable drawers and/or shelves.

Figure 57 shows a cabinet (550) including a top (552), a bottom (554), side walls (556, 557), and a back wall (558). The cabinet also has a front opening (567). The side walls (556, 557) have a plurality of openings or apertures (560) therein. The cabinet (550) is constructed with a double-wall construction having outer walls (582, 584) overlying the side walls (556, 557). As shown in Figure 59, a space (586) extends between the side walls and outer walls.

In the exemplary embodiment a first series (562) of openings are elongated in a horizontal direction and are arranged with a predetermined spacing both horizontally and vertically on the interior side walls (556, 557) of the cabinet. The series (562) of openings includes a first row vertically spaced and aligned adjacent the front opening (567) and a second row of vertically

aligned and spaced adjacent the back wall (558) of the cabinet. It should be understood that in alternative embodiments other arrangements may be used.

In the exemplary embodiment the plurality of openings (560) further include a second series (564) of openings. The openings in the second series are elongated in a vertical direction. The second series (564) is arranged with a predetermined spacing both horizontally and vertically to complement the first series (562).

Adjacent openings in the first and second series (562, 564) can be generally perpendicular slots that may form an L-shape as shown in Figures 57 and 58. Each pair of adjacent openings from the first series and the second series comprises a set (588) as shown in Figure 58. A pair of complementary sets comprise an arrangement (590) as shown in Figure 57 by a dashed line. The plurality of arrangements (590) are spaced in each side wall (556, 557) to complement each other and be arranged at generally the same vertical elevation. It should again be understood that other arrangements may be used in alternative embodiments.

In the exemplary embodiment each arrangement of apertures is adapted to engage a releasible connective member, such as a bracket (566) as shown in Figure 56. A bracket (566) may be attached in operative connection with an item supporting member, such as a drawer guide (574) as shown in phantom in Figure 56. The bracket (566) may be a substantially flat elongated member including a tab or projection (568) at each end. The tabs (568) extend outwards from one side of the bracket in a first direction. The tabs also extend substantially at a right angle to the main body of the bracket. The bracket (566) further includes finger projections (570). The

finger projections are also at each end and have a portion which extends in a second direction away from the upper edge and away from a tab.

As shown in Figure 59 the projections (570) are bent in an S-shape and extend in the first direction like the tabs (568). The projections (570) include an inner portion (592) which extends in generally the first direction. The inner portion (592) extends generally horizontally through a corresponding horizontally elongated aperture (594). The projection (570) also includes an end portion (596). The end portion (596) extends in a second direction generally transverse to the first direction and away from a tab projection (568). In this way when the bracket (566) is in an operative position, the end portion (596) may extend generally vertically in the space (586) between the interior side wall (557) and the outer wall (584). The end portion (596) can secure the bracket (566) to prevent horizontal movement thereof when the bracket is in the operative position.

The installation of the bracket (566) in operative supporting connection with the wall (557) can be accomplished by first extending the end portion (596) in a generally horizontal direction and passing it through an aperture (594). Once the end portion passes through the aperture the bracket (566) may be rotated such that the end portion (596) moves toward the vertical position and the inner portion (592) of finger projection (570) extends in the aperture (594). As the bracket (566) is rotated, the tab projection (568) is moved to extend into an aperture (598) which is part of a set with the aperture (594). The engagement of tab projection (568) in the aperture (598) can provide vertical support for the bracket (566).

In the exemplary embodiment, each bracket (566) includes two finger projections (570) and a pair of tab projections (568). A medical item supporting member such as a drawer (628) or shelf (626) (e.g., Figure 63), may be extended across the interior area of the cabinet supported by the brackets. With the adjacent drawer or shelf removed, the brackets can be readily disengaged and vertically repositioned in other apertures. This enables readily installing and/or changing the positions, arrangements, and types of shelves and drawers within the cabinet.

## **CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW**

The questions presented in this appeal are:

- 1). Whether Appellant's claims 1-56 are unpatentable under 35 U.S.C. § 112, second paragraph.
- 2). Whether Appellant's claims 1-19, 29-36, 40-48, and 53-56 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Bach.
- 3). Whether Appellant's claims 20-28 and 37-39 are unpatentable under 35 U.S.C. § 103(a) over Lipps in view of Bach et al.
- 4). Whether Appellant's claims 1-56 are unpatentable under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent 5,961,036 in view of Bach et al.
- 5). Whether Appellant's claims 1-56 are unpatentable under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent 6,073,843 in view of Bach et al.



- 6). Whether Appellant's claims 1-56 are unpatentable under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent 5,957,372 in view of Bach et al.
- 7). Whether Appellant's claims 1-56 are unpatentable under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent 5,790,409 in view of Bach et al.
- 8). Whether Appellant's claims 1-56 are unpatentable under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of U.S. Patent 6,163,737 in view of Bach et al.
- 9). Whether Appellant's claims 1-56 are unpatentable under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent 5,404,384 in view of Bach et al.
- 10). Whether Appellant's claims 1-56 are unpatentable under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent 5,533,079 in view of Bach et al.
- 11). Whether Appellant's claims 1-56 are unpatentable under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent 5,971,593 in view of Bach et al.
- 12). Whether Appellant's claims 1-56 are unpatentable under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent 5,993,046 in view of Bach et al.

## **GROUPING OF CLAIMS**

No groups of claims stand or fall together. Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

Each of Appellant's claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

The pending claims include six independent claims (claims 1, 29, 40, 41, 44, and 53). Claims 2-28 depend from claim 40. Claims 30-39 and 42-43 depend from claim 41. Claims 45-52 depend from claim 44. Claims 54-56 depend from claim 53. All pending claims 1-56 are reproduced in the Appendix.

## **ARGUMENT**

### **The Applicable Legal Standards**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg.*

Co., 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

#### **The Bach Reference**

The applied "Bach" reference is not of record. Thus, the rejections relying on the Bach reference are unclear. However, to avoid further prosecution delay by the Office, Appellant has presumed that the applied Bach reference is Bach et al. (U.S. Patent No. 5,378,057). Appellant reserves all rights to amend the arguments, including the filing of a reply brief, if the applied Bach reference is not U.S. Patent No. 5,378,057.

#### **The Bach et al Reference**

Bach et al. (U.S. Patent No. 5,378,057; hereinafter "Bach") is directed to a metal case. The metal case (20) has an adaptable capability between a lateral file or a cabinet which includes an inner framework (120) comprised of a plurality of corrugated metal panels (122, 124, 126),

each having a similar cross-sectional configuration and substantially extending the depth and length of the case. The panels are arranged horizontally and vertically to form a box-like structure which may be encased in a one-piece, metal outer wrapper (80) and finished with a top pan (40) and a base pan (60), thereby concealing spot welds which partially secure the inner framework to the outer wrapper. The inner framework is further secured to the outer wrapper by adhesive, which also provides acoustical insulation. The vertical panels (126) include equidistantly placed, symmetrically arranged openings (170) which may accommodate either self-locating, snap-in door hinges (240) for a storage cabinet with shelves (230) embodiment or unhanded, snap-in drawer glides (200) for a lateral file embodiment.

### **The Lipps Reference**

Lipps (U.S. Patent No. 5,805,455) is directed to methods for dispensing items. Lipps shows a dispensing unit (10) including a cabinet (12) with shelves (20) and doors (28). The dispensing unit also includes a processor (33) with a manual key lock (58) on the face thereof (col. 6, lines 35-49) for switching modes (e.g., dispensing, restocking).

Upon selection of a desired item from a list of items held by the dispensing unit, a visual indicator (46) corresponding to the selected item can be actuated so that the selected item can be quickly located (col. 5, lines 56-67). The unit also includes touch-activated item switches (42) connected to the processor so that a user can input records of removed items into the processor.

### **The Nine U.S. Patents Asserted as the Basis for Double Patenting Rejections**

Only the subject matter claimed in the U.S. patents referred to in the obviousness-type double patenting rejections may be considered. The entire disclosures of these U.S. patents may not be used as the basis for such a rejection. The subject matter in each patent's claims is self evident.

#### **(ii) 35 U.S.C. § 112, Second Paragraph**

Claims 1-56 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. These rejections are respectfully traversed. Appellant respectfully submits that the recited subject matter is not complex and is easily understandable to one having ordinary skill in the art.

As indicated in the "Overview of dates and papers associated with this application", the Office presented at least four previous Actions (e.g., a first rejection; a first restriction; a second different restriction; and a second non final rejection) prior to the appeal. Yet the Office first alleges indefiniteness in the March 5, 2002 Office Action. It is ironic that the claims which the Office previously held on many occasions to be definite, are now held to be indefinite.

The Action alleges indefiniteness based on the language "horizontal apertures." However, none of the claims recite "horizontal apertures" as alleged. Rather claim 1, which comes closest to the allegation, recites a "wall including at least two sets of generally horizontally disposed apertures therein, wherein each set of apertures includes a first aperture and a second aperture, wherein the first aperture is disposed vertically above the second aperture." Appellant

respectfully submits that the Action also confuses the term "elongated" with the term "disposed."

Especially since the term "elongated" is not even recited in claim 1.

Claim 1 finds basis in the Specification, for example at least at page 75, lines 1-10 and Figures 57-58. Therefore, in an exemplary embodiment of the invention the portion of claim 1 can read as follows: a wall (556) including at least two sets (588) of generally horizontally disposed apertures therein, wherein each set (588) of apertures includes a first aperture (562) and a second aperture (564), wherein the first aperture (562) is disposed vertically above the second aperture (564).

Of course, it should be understood that this referenced portion of claim 1 is for discussion purposes only and that the claim is not limited to the embodiment presented. No unnecessary limitations are to be implied from using such referenced claim portion for discussion purposes. All of the claims are to remain broadly construed. Moreover, the descriptions given are by way of examples and the invention is not limited to the exact details of the examples shown or described.

For the reasons discussed above, claim 1 is not indefinite. It follows that all of the claims are likewise definite. Thus, Appellant respectfully requests that the rejections be withdrawn.

### **(iii) 35 U.S.C. § 102**

The Action's reliance on the description (beginning on Action page 5, line 1) of the Krivec reference is noted. That is, the 35 U.S.C. § 102(b) rejections based on Bach also rely on the Krivec disclosure. However, anticipation pursuant to 35 U.S.C. § 102 requires that a single

prior art reference contain all the elements of the claimed invention. For these reasons, Appellant respectfully requests that the rejections be withdrawn. Nevertheless, neither Bach nor Krivec anticipate the claims.

### **The Pending Claims Are Not Anticipated By Bach**

In the Action claims 1-19, 29-36, 40-48, and 53-56 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bach. These rejections are respectfully traversed. Bach does not teach the recited combination of elements.

Neither Bach nor Krivec anticipate the claims. With regard to claims 1, 29-36, 40-48, and 53-56 the Action alleges a teaching of a supporting structure (126); first aperture (176); second aperture (178, 180); connecting member (202); projecting portions (214, 216; or 214, 220); first projection (214); second projection (216); wall (Figure 15); and inner portion (Figure 21).

### **Claim 1**

Claim 1 is an independent claim directed to an apparatus. Bach does not disclose at least the features:

- (A) • "each set of apertures includes a first aperture and a second aperture, wherein the first aperture is disposed vertically above the second aperture" and the "releasible connecting member includes two disposed pairs of projecting portions corresponding to the sets of apertures."



- (B) • "each pair of projecting portions includes a first projection and a second projection" and "the first projection includes an end portion, wherein the end portion extends generally transverse to the first direction and away from the second projection"
  - (C) • rotating the connecting member relative to the wall to the operative position by "extending the end portions of the first projections in the first apertures of the sets and then rotating the connecting member relative to the wall to the operative position wherein the inner portions extend in the first apertures and the second projections extend in the second apertures."
- rotating the connecting member relative to the wall to the operative position

Bach does not disclose feature (A)

Bach does not teach that each alleged set of apertures (176, 178; 176, 180) includes a first aperture (176) and a second aperture (178, 180), especially where the first aperture is disposed vertically above the second aperture. Bach does not teach a releasible connecting member including two disposed pairs of projecting portions corresponding to the generally horizontally disposed and vertically disposed apertures in a wall. It is unclear how only the three alleged projecting portions (214, 216, 220) can constitute two pairs (i.e., at least four) of projecting portions. That is, three does not qualify as four. Bach cannot anticipate the claim.

Bach does not disclose feature (B)

Bach's tab (214) and tab (216) cannot respectively constitute the recited first projection and a second projection. Bach does not teach that the alleged first projection (214) includes an

end portion that extends generally transverse to the first direction and away from the alleged second projection (216). Rather, Bach's T-shaped tabs (214, 216) are identical and extend in the same direction.

Nor can Bach's tab (214) and clip (220) respectively constitute the recited first projection and a second projection. The tab (214) cannot constitute the first projection because it does not have the recited inner and end portions. The clip (220) cannot constitute the second projection because it is not vertically above the alleged first projection (214). Bach cannot anticipate the claim.

Bach does not disclose feature (C)

Bach does not teach that a connecting member can be placed in supporting connection with a wall by extending end portions of first projections in first apertures of sets, and then rotating the connecting member relative to the wall to the operative position such that inner portions extend in the first apertures and the second projections extend in second apertures.

As previously discussed, Bach does not teach the recited first projection end portion. Because Bach does not teach the end portion structure, the alleged connecting member (202) cannot be placed in supporting connection with a wall in the manner recited. That is, the alleged connecting member (202) cannot be positioned so that first projection end portions extend into first apertures, and then rotated so that the first projection inner portions extend in the first apertures and the second projections extend in the second apertures.

Bach does not teach rotating. Nor does Bach teach a connecting member structure adapted to permit supporting connection by rotation, especially when the alleged first projection (214) and second projection (216) are identical. Thus, Bach cannot anticipate the claim.

As shown by Appellant, Bach does not teach each and every element of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Hence, Appellant's claim 1 patentably distinguishes over the Bach reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection should be withdrawn.

### **Claim 2**

Claim 2 depends from claim 40. The Action is silent as to where Bach teaches the recited features. The Action alleges a first projection (214). However, teach that the alleged first projection (214) extends from a connecting member body. Nor does Bach teach the first projection having an end portion that extends generally transverse to the first direction and away from the second projection. Bach also does not teach that in the operative position a first projection end portion and a body extend on opposed sides of a vertically extending wall. Thus, Bach cannot anticipate the claim.

### **Claim 3**

Claim 3 depends from claim 2. Bach does not teach the recited first projection end portion or the recited outer wall in the manner recited. Nor does Bach teach that a first projection end portion extends in a space between a vertically extending wall and the alleged outer wall (80).

#### **Claim 4**

Claim 4 depends from claim 40. The Action is silent as to where Bach teaches the recited features. Bach does not teach that a connecting member is selectively vertically positionable relative to a vertically extending wall to engage any arrangement of apertures, especially where a horizontally disposed pair of sets of apertures comprise the arrangement. In an exemplary embodiment of the invention a pair of horizontally disposed sets (588) comprise an arrangement (590) as indicated in Figure 57 by a dashed line (Specification page 75, lines 1-10).

#### **Claim 5**

Claim 5 depends from claim 40. Bach does not teach a connecting member and a moveable item supporting member in the manner recited. Hence, Bach cannot anticipate the claim.

#### **Claim 6**

Claim 6 depends from claim 5. Bach does not teach an apparatus with a moveable item supporting member in the manner recited.

#### **Claim 7**

Claim 7 depends from claim 4. Bach does not teach the recited structural relationships of a first wall, second wall, corresponding arrangements of apertures, a first connecting member, a second connecting member, and an item supporting member in the manner recited. Thus, Bach cannot anticipate the claim.

#### **Claim 8**

Claim 8 depends from claim 7. Again, Bach does not teach the previously recited structure. It follows that Bach cannot teach the recited movable item supporting member.

#### **Claim 9**

Claim 9 depends from claim 8. Bach does not teach a plurality of item supporting members, each independently moveably mounted in the manner recited. Hence, Bach does not anticipate the claim.

#### **Claim 10**

Claim 10 depends from claim 8. Again, Bach does not teach the previously recited structure. It follows that Bach cannot anticipate the claim.

#### **Claim 11**

Claim 11 depends from claim 8. The Action is silent as to where Bach teaches the recited features. Bach does not teach a shelf in the manner recited. Bach's shelf (230) does not correspond to the recited support structure. Bach does not teach the shelf (230) with first and second connecting members, where the connecting members include two disposed pairs of projections, and vertically disposed arrangements of apertures, where a horizontally disposed pair of sets of apertures comprise an arrangement. Nor can Bach anticipate the claim.

Because Bach does not teach the recited structure, the Action (on page 11) attempts to stretch the definition of a drawer to read on a shelf. Nevertheless, the relied upon dictionary page document (and definition) is not of record, and is thus inadmissible. However, the Action and Bach both acknowledge that a drawer differs from a shelf. Likewise, one having ordinary skill in

the art would recognize (and a dictionary would verify) that a drawer differs from a shelf.

Further, because of the differences, Bach has to use different supporting structure. However, in an exemplary embodiment of the invention, different supporting structure is not required. In an example of supporting basis, both a shelf (626) and a drawer (628) may be found in Appellant's Figure 63.

Furthermore, the Action refers to "art-known equivalents." Apparently, the Examiner is confusing anticipation with obviousness. However, the rejection is not based on an allegation of obviousness. Nevertheless, the Action's reference to "art-known equivalents" is taken as an admitting by the Office that Bach does not teach a shelf in the manner recited.

Additionally, the Action cannot allege that Bach's same member (100) constitutes both a drawer (claim 10) on one hand and also a shelf (claim 11) on the other hand. Thus, for these many reasons, Bach does not anticipate the claim.

### **Claim 12**

Claim 12 depends from claim 9. As previously discussed, Bach does not teach relationships of the first and second arrangements of apertures with the first and second connecting members. It follows that Bach cannot teach the recited vertically spaced supporting members.

### **Claim 13**

Bach does not teach that a second vertical distance (related to the spacing of first and second arrangements of apertures) is smaller than a first vertical distance (related to spacing of item supporting members). In an example of supporting basis, Figures 57 and 62-63 show

arrangements (590) of apertures (Figure 57) spaced smaller than the spacing of item supporting members (e.g., drawers; Figures 62-63). The Action (at page 12) incorrectly refers to sets of apertures with regard to Bach's Figure 8, instead of the recited arrangements of apertures.

#### **Claim 14**

Claim 14 depends from claim 40. The Action (on page 6) alleges that Bach has a first aperture (176) and a first projection (214). Bach does not teach that an alleged first projection extends into and substantially fills the alleged first aperture. Note Bach's Figure 17. Thus, Bach does not anticipate the claim.

#### **Claim 15**

Claim 15 depends from claim 40. The Action (on page 6) alleges that Bach has a second aperture (178, 180) and a second projection (216, 220). However, the alleged second aperture (178) cannot constitute a second aperture because it is not elongated vertically. Nor does the alleged second projection (216) substantially fill the alleged second aperture (178). Appellant questions whether the alleged second aperture (180) is elongated vertically. Nevertheless, the alleged second projection (220) is not elongated vertically, but horizontally. It follows that the alleged second projection (220) projection cannot extend in and substantially fill the alleged vertically elongated second aperture (180). Thus, Bach does not anticipate the claim.

#### **Claim 16**

Claim 16 depends from claim 40. The Action (on page 6) alleges that Bach has a first aperture (176) and a first projection (214). The Action (on page 6) also alleges that Bach has a second aperture (178, 180) and a second projection (216, 220). As previously discussed (e.g.,

claims 14 and 15), Bach teaches neither the first aperture/projection configuration nor the second aperture/projection configuration. It follows that Bach cannot anticipate the claim.

#### **Claim 17**

Claim 17 depends from claim 40. Claim 17 recites that in "each of the sets" (instead of at least a pair of sets; claim 40) of apertures the second aperture is disposed horizontally from the first aperture.

The Action is silent as to where Bach teaches the recited features. As previously discussed, Bach does not teach the recited sets of apertures. Each set includes a first aperture disposed vertically from a second aperture (claim 40). Each set further includes the second aperture disposed horizontally from a first aperture (claim 17). Bach does not teach the recited sets of vertically and horizontally apertures. Nor can Bach anticipate the claim.

#### **Claim 18**

Claim 18 depends from claim 17. The Action is silent as to where Bach teaches the recited features. As previously discussed, Bach does not teach the recited pair of sets of apertures. Each set includes a first aperture disposed vertically from a second aperture (claim 40). Each set further includes the second aperture disposed horizontally from a first aperture (claim 17). Furthermore, the second apertures in the pair of sets are spaced further apart horizontally than the first apertures in the pair of sets. Bach does not teach the recited apertures. Bach cannot anticipate the claim.



### **Claim 19**

Claim 19 depends from claim 7. As previously discussed, Bach does not teach the recited connecting members to walls relationship. It follows that Bach does not teach having each connecting member configured to be engageable in the operative position with either wall. It further follows that Bach does not anticipate the claim.

### **Claim 29**

Claim 29 is an independent claim directed to an apparatus. Note Appellant's remarks in support of the patentability of claim 1.

The Action is silent as to where Bach teaches the recited features. That is, the Action is silent as to what elements in Bach allegedly correspond to the recited features. Nevertheless, Bach does not teach the recited features.

Bach has a drawer glide (200) with telescoping rails (202, 204, 206) and ball bearings (col. 7, line 63 to col. 8, line 2). The drawer glide rail (202) includes the tabs (214, 216) (col. 8, lines 14-21). Bach does not teach a bracket.

Nor does Bach teach a drawer guide in operatively fixed connection with a bracket. Nor does Bach teach a bracket having a substantially flat elongated member. Nor does Bach teach an elongated member having a tab portion adjacent each longitudinal end. Even if Bach's tabs (214, 216) were somehow part of a bracket, they are only at one end. Nor does Bach teach an elongated member having a finger portion adjacent an upper edge thereof. Bach's tabs are positioned about a horizontal centerline (col. 8, lines 31-35). Nor does Bach teach having each tab portion (adjacent each longitudinal end) extending in the (same) first direction, and a finger

portion (adjacent an upper edge) extending generally transverse to the first direction. Bach does not teach the recited structure. It follows that Bach cannot anticipate claim 29.

#### **Claim 30**

Claim 30 depends from claim 41. The Action is silent as to where Bach teaches the recited features. Bach does not teach a series of horizontally aligned and vertically spaced openings in each side wall, and where bracket finger portions and tab portions are releasibly engageable in the openings. In an example of an exemplary embodiment, Figures 56, 57, and 59 show a series of vertically spaced openings (562), wherein a finger portion (570) is releasibly engageable in each of the openings of a first series. Bach does not anticipate the claim.

#### **Claim 31**

Claim 31 depends from claim 30. The Action is silent as to where Bach teaches the recited features. Bach does not teach a tab portion adjacent each longitudinal end (claim 41), and a finger portion adjacent each longitudinal end (claim 31). Bach does not teach the recited structure. Thus, Bach cannot anticipate the claim.

#### **Claim 32**

Claim 32 depends from claim 30. The Action is silent as to where Bach teaches the recited features. Bach does not teach the recited structural arrangement of openings in a cabinet wall. Nor does Bach teach the openings having a size to receive a finger portion of a bracket in the manner recited. It follows that Bach cannot anticipate the claim.

### **Claim 33**

Claim 33 depends from claim 30. The Action is silent as to where Bach teaches the recited features. Bach does not teach a first series of openings vertically spaced on each side wall, especially where the openings are capable of having a bracket finger portion engageable in each of the first series openings (claim 30), nor a second series of openings vertically spaced on each side wall, especially where a bracket tab portion is releasibly engageable in each of the second series openings (claim 33). Thus, Bach cannot anticipate the claim.

### **Claim 34**

Claim 34 depends from claim 33. Bach does not teach a second series of openings including in each side wall, one row of vertically spaced openings and a second row of vertically spaced openings, especially where the openings in the first row are horizontally disposed from the openings in the second row. Bach does not teach the recited first and second series of openings. It follows that Bach cannot anticipate the claim.

### **Claim 35**

Claim 35 depends from claim 34. Bach does not teach the recited structural arrangement of openings in a cabinet wall. Nor does Bach teach the openings having a size to receive a tab portion of a bracket. It follows that Bach cannot anticipate the claim.

### **Claim 36**

Claim 36 depends from claim 41. Bach does not teach a cabinet including an outer wall in the manner recited. Nor does Bach teach that a finger portion extends in the space between a side wall and the outer wall. Nor does Bach anticipate the claim.

#### **Claim 40**

Claim 40 is an independent claim directed to an apparatus. Note Appellant's remarks in support of the patentability of claim 1.

Bach does not teach the combination of a pair of aperture sets disposed generally horizontally,

where each set includes a first aperture disposed vertically from a second aperture; and

a releasible connecting member including two disposed pairs of projecting portions,

with each pair including a first projection and a second projection,

so that in the operative position each respective first projection extends in a respective first aperture and each respective second projection extends in a respective second aperture.

Bach does not teach the recited features and relationships. Bach does not teach the projection and aperture structural arrangement. The Action (on page 6) alleges that Bach has a first aperture (176) and a first projection (214). The Action (on page 6) also alleges that Bach has a second aperture (178, 180) and a second projection (216, 220). Bach does not teach that each first projection extends in a respective first aperture, especially where the first aperture is included in a set with a second aperture, where the set is disposed generally horizontally from another set of apertures, and in each set the first aperture is disposed vertically from the second aperture. Bach also does not teach that each second projection extends in a respective second

aperture, especially where the second aperture is included in a set with a first aperture, the set is disposed generally horizontally from another set of apertures, and in each set the first aperture is disposed vertically from the second aperture.

Bach's alleged first (214) and second (216, 220) projections do not match first and second apertures in the manner recited. Nor does Bach have pairs of the alleged first and second projections corresponding to vertically disposed apertures in horizontally disposed sets. Where does Bach have horizontally disposed sets of vertically disposed first and second apertures, with corresponding first and second projections? The alleged pairs of first (214) and second (216, 220) projections do not match the alleged sets of first (176) and second (178, 180) apertures. It is unclear how the (only) three alleged projections (214, 216, 220) can constitute two pairs (i.e., at least four) of projections. That is, three does not qualify as four.

Bach also does not teach that each first projection includes an inner portion that extends from the connecting member in generally the same (first) direction that each second projection extends from the connecting member. Bach further does not teach that each first projection includes an end portion that extends generally transverse to the first direction and away from the second projections.

Bach cannot anticipate claim 40. Hence, Appellant's claim 40 patentably distinguishes over the Bach reference.

#### **Claim 41**

Claim 41 is an independent claim directed to an apparatus. Note Appellant's remarks in support of the patentability of claims 1 and 29.

The Action is silent as to where Bach teaches the recited features. Nor does Bach teach the recited features. As previously discussed, Bach does not teach the brackets (e.g., claim 29) or the side wall openings. Bach does not teach a pair of brackets, each including a substantially flat elongated member having a tab portions and finger portions. For example, a bracket (566) with tabs (568) and fingers (570) such as in Figure 56.

Bach does not teach a bracket member having tab portions and finger portions (i.e., at least four projections). Even the Action (on page 6) alleges that Bach only has a first projection (214) and second projections (216, 220). It is unclear how the (only) three alleged projections (214, 216, 220) can constitute at least four projections. That is, three does not constitute four.

Nor does Bach teach a bracket member having tab portions adjacent each longitudinal end of the elongated member, and the tab portions extend in a first direction. Nor does Bach teach finger portions adjacent an edge of the elongated member, where each finger portion includes a projection, and the finger portion projections extend generally transverse to the first direction. Nor does Bach teach side wall openings spaced and configured to receive the bracket finger portions and tab portions. Bach cannot anticipate claim 41.

#### **Claim 42**

Claim 42 depends from claim 41. The Action is silent as to where Bach teaches the recited features. As previously discussed, Bach does not teach the recited tab portions and finger portion projections of a bracket. Nor does Bach teach that a second distance (of finger outer edges) is greater than a first distance (of tab outer edges). It follows that Bach cannot anticipate the claim.

The alleged pairs of first (214) and second (216, 220) projections do not match the alleged sets of first (176) and second (178, 180) apertures.

**Claim 43**

Claim 43 depends from claim 42. Bach also does not teach a bracket of which fingers extend from a bracket edge a greater distance than tab portions extend from a bracket side. It follows that Bach cannot anticipate the claim.

**Claim 44**

Claim 44 is an independent claim directed to an apparatus. The Action is silent as to where Bach teaches the recited features. Bach does not teach each side wall including a plurality of first and second pairs of apertures. For example, first pairs (562) and second pairs (564) such as in Figure 57. Bach does not teach a support simultaneously engageable with a first pair aperture (wherein the apertures in each first pair are disposed from and aligned with one another in a horizontal direction) and a second pair aperture (wherein the apertures in each second pair are disposed from and aligned with one another in the horizontal direction). Bach does not teach a support that is capable of simultaneously engaging both a first horizontal pair aperture and a second horizontal pair aperture.

Nor does Bach teach a medical item cabinet and a medical item supporting structure. Bach is non analogous art. Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the (medical item) feature alleged to be inherent is "necessarily present" in Bach. Inherency may not

be established based on probabilities or possibilities (which is the current situation). *In re Robertson*, supra. The Action has not proved inherency. Where does Bach implicitly or explicitly refer to housing and supporting medical items? The rejection is based on pure speculation. The record lacks the required substantial evidence support. *In re Zurko*, supra. Hence, Bach does not anticipate the claim.

#### **Claim 45**

Claim 45 depends from claim 44. Bach does not teach that the apertures in each first pair are disposed from and aligned with one another in a horizontal direction (claim 44). Bach further does not teach that each of the apertures in each first pair is elongated in the horizontal direction (claim 45). Thus, Bach cannot anticipate the claim.

#### **Claim 46**

Claim 46 depends from claim 44. Bach does not teach that the apertures in each second pair are disposed from and aligned with one another in a horizontal direction (claim 44) and are vertically elongated (claim 46) in the manner recited. Thus, Bach cannot anticipate the claim.

#### **Claim 47**

Claim 47 depends from claim 45. As previously discussed, Bach does not teach a pair of horizontally elongated apertures that are also disposed from and aligned with one another in a horizontal direction (claim 45) and that apertures in each second pair are vertically elongated (claim 47). Bach does not teach horizontally and vertically elongated apertures in the manner recited. Thus, Bach cannot anticipate the claim.



#### **Claim 48**

Claim 48 depends from claim 44. Bach does not teach a pair of slides in the manner recited. Bach does not anticipate the claim. A slide (574), for example, is shown in Figure 56.

#### **Claim 53**

Claim 53 is an independent claim directed to an apparatus. The Action is silent as to where Bach teaches the recited features. Note Appellant's remarks in support of the patentability of claim 44.

Bach does not teach a plurality of medical item supporting structures releasibly supported and selectively vertically positionable in the interior area of a medical item cabinet, with each medical item supporting structure in supporting connection with both of the cabinet side walls through engagement of a plurality of projections and apertures. Further, as previously discussed, The Office has not proved that the (medical item) feature is "necessarily present" in Bach. Bach does not implicitly or explicitly teach medical item supporting structures. Thus, Bach cannot anticipate the claim.

#### **Claim 54**

Claim 54 depends from claim 53. As previously discussed, Bach does not teach the recited features of claim 53. It follows that Bach also does not teach that each side wall set is vertically disposed from and parallel to at least one other side wall set. Thus, Bach cannot anticipate the claim.

### **Claim 55**

Claim 55 depends from claim 54. Bach does not teach that each set comprises a pair of apertures, and a pair of projections is engaged in the pair of apertures in the manner recited. Hence, Bach does not anticipate the claim.

### **Claim 56**

Claim 56 depends from claim 54. Bach does not teach the recited combination of features. Bach does not teach sets, each including a first pair of apertures and a second pair of apertures, especially where each of the apertures in each first pair is horizontally elongated and each of the apertures in each second pair is vertically elongated. Thus, Bach cannot anticipate the claim.

### **(iv) 35 U.S.C. § 103**

Appellant respectfully submits that neither Bach et al. nor any of the other references taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. Furthermore, even if it were somehow possible for a reference to have disclosed certain features as alleged, it would still not have been obvious to have combined features of the references as alleged. Additionally, even if it were somehow possible for the references to be combined as alleged, the combined references still would not have produced Appellant's claimed invention.

All of the 35 U.S.C. § 103(a) rejections rely on Bach to teach (anticipate) the features and relationships of independent claims. However, as previously discussed, Bach fails to teach or

suggest the subject matter recited in these independent claims. It follows that Bach cannot alleviate the deficiencies of any of the other references. That is, because the 35 U.S.C. § 103(a) rejections rely on a faulty assertion of Bach they are also without merit. Thus, it would not have been obvious to have modified or combined the references so as to have produced Appellant's claimed invention.

The Action does not state in any way that is reasonably understandable by Appellant, where the specific features recited in Appellant's claims are allegedly found in the references. Not one rejection based on prior art has specifically and understandably labeled the claimed features allegedly found in each applied reference. Nor is there any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellant. Furthermore, it is respectfully submitted that the Action is not in compliance with MPEP § 707.07(d) which clearly states “where a claim is refused for any reason relating to the merits thereof it should be rejected and the ground of rejection fully and clearly stated.” The Action’s failure to specifically indicate the presence of the recited claim features in the references constitutes Agency Action under the Administrative Procedures Act admitting that the references do not meet the recited claim features. For this reason it is respectfully submitted that the Action fails to establish a *prima facie* case of obviousness against any of the claims and the rejections should be withdrawn.

Because the Action fails to directly apply the references to the claims, Appellant has been unduly burdened by having to speculate as to possible rationales for the rejections. Appellant has reviewed the references cited and has determined that the cited references, taken individually or

as a whole, clearly do not teach or suggest the invention recited in Appellant's claims. Therefore, the presented claims would not have been obvious to one having ordinary skill in the art.

Additionally, the attempts to modify each of the primary references are clearly attempts at hindsight reconstruction of Appellant's claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellant's disclosure. It follows that it would not have been obvious to have combined the references in the manner alleged. Further, without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01). Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

The applied references, taken alone or in combination, neither disclose nor suggest the recited features and relationships. Thus, it would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the recited invention. The Office does not factually support any *prima facie* conclusion of obviousness. If the Office does not produce a *prima facie* case, which is the current situation, then the Appellant is under no obligation to submit evidence of nonobviousness (MPEP § 2142). Appellant respectfully submits that the rejections are improper and should be withdrawn.

**The Pending Claims Are Not Obvious Over  
Lipps in view of Bach**

In the Action claims 20-28 and 37-39 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lipps in view of Bach. Appellant traverses these rejections on the grounds that Appellant's claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellant's invention. The features recited in Appellant's claims patentably distinguish over the applied references.

The Action (on page 15) alleges that Lipps discloses a medical cabinet. The Action admits that Lipps does not disclose the features of claims 1-19. The Action alleges that Bach discloses a cabinet, and that it would have been obvious to have used the cabinet configuration of Bach in the cabinet of Lipps. The Action's alleged motivation for combining is to "provide an interlock apparatus which avoids the disadvantages of the prior assemblies while affording structural and operational advantages" and refers to col. 1, lines 38-40 of an unknown reference.

The Appellant disagrees. First, neither Bach nor Lipps mention the quoted "interlock apparatus" language, especially at a referred to col. 1, lines 38-40. Thus, the Action's motivation for combining is lacking and is without basis.

Nevertheless, as previously discussed, Bach fails to teach or suggest the recited features of the claims from which claims 20-28 and 37-39 depend. It follows that Bach cannot be used to alleviate the admitted deficiencies in the Lipps reference. That is, even if it were somehow

possible for Lipps to have been modified by Bach (which it isn't), the resultant combination still would not have produced the claimed invention.

Furthermore, it would not have been obvious to have modified Lipps as alleged. There is no evidence that Lipps could be modified in the manner alleged. Nor are the structures of Lipps and Bach compatible. Lipps desires that the doors (28) and sides of the cabinet remain transparent (col. 3, lines 19-23). Therefore, Lipps' shelves (20) are not supported at a side wall. Nor is there any desire or need to support the shelves (20) at a side wall. Rather, the shelves (20) of Lipps are supported in the columns (18) at corner frameworks (Figure 1; col. 3, lines 24-26).

It follows that it would not have been obvious to have substituted the transparent wall of Lipps with the apertured solid wall of Bach. Nor would it have been obvious to have placed the alleged first (214) and second (216, 220) projections of Bach through the transparent wall of Lipps. In Lipps the horizontally adjacent compartments share a common side wall. Even if it were somehow possible to place the projections of Bach into a transparent common side wall of Lipps, the projections on one side of the wall would interfere with the projections on the other side of the wall because both projections would have to share the same wall. Thus, not only would the proposed modification to Lipps ruin the desired transparency, but it would also appear impossible.

The alleged modification to Lipps (if somehow possible) would destroy the disclosed and desired utility or operability of the Lipps teaching. That is, the alleged modification to Lipps would render the reference inoperable for its intended purpose.

An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, it would not have been obvious to one having ordinary skill in the art to have modified Lipps to have produced Appellant's recited invention. Thus, the Office has not established a *prima facie* showing of obviousness.

The Action (on page 15) also alleges, regarding the rejection of claims 20-28, that one "skilled in the art is capable of and would find it necessary to perform the method as described."

The Appellant respectfully disagrees. It is unclear as to why one skilled in the art would find it "necessary" to perform the methods of claims 20-28. Nor has the Action provided any valid rationale.

Any attempt to have combined Lipps with Bach is clearly an attempt at hindsight reconstruction of Appellant's claimed invention, which is legally impermissible. The rejection, which lacks the necessary evidence and rationale as previously discussed, is based on knowledge gleaned only from Appellant's disclosure. It follows that it would not have been obvious to one having ordinary skill in the art to have modified the Lipps reference in the manner alleged. It is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

#### **Claim 20**

Claim 20 depends from claim 19/7/4/40. The Action is silent as to where the applied references disclose or suggest the recited features and relationships. The Action (on page 15) merely indicates that the rejection relies on using the cabinet configuration of Bach in the alleged

modification of Lipps. However, Bach does not disclose or suggest the recited removing and installing steps of claim 20. Nor would Lipps, modified with the cabinet configuration teachings of Bach, have produced the recited steps. It follows that the applied references, taken alone or in combination, neither disclose nor suggest the recited features and relationships. The Office has not established a *prima facie* showing of obviousness. Therefore, it would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention.

#### **Claim 21**

Claim 21 depends from claim 19/7/4/40. The Action is silent as to where the applied references disclose or suggest the recited features and relationships. Again, the rejection merely relies on using the cabinet configuration of Bach in the alleged modification of Lipps. However, as previously discussed, Bach does not teach or suggest the features. Therefore, Bach cannot be relied upon to teach or suggest removing a connecting member from a wall. It follows that the applied references, taken alone or in combination, neither disclose nor suggest the recited features and relationships. Thus, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 22**

Claim 22 depends from claim 21. As previously discussed, Bach cannot be relied upon to teach or suggest removing a connecting member from a wall (claim 21). Nor can Bach be relied upon to teach or suggest reinstalling a connecting member with a wall (claim 22). Again, the Office has not established a *prima facie* showing of obviousness.



### **Claim 23**

Claim 23 depends from claim 22 which depends from claim 21. As previously discussed, the applied references, taken alone or in combination, neither disclose nor suggest the recited features and relationships of claims 22 or 21. Additionally, none of the applied references teach or suggest reinstalling a connecting member with a different arrangement of apertures in a wall. Again, the Office has not established a *prima facie* showing of obviousness.

### **Claim 24**

Claim 24 depends from claim 19/7/4/40. The Action is silent as to where the applied references disclose or suggest the recited features and relationships. The rejection merely relies on using the cabinet configuration of Bach in the alleged modification of Lipps. However, the applied references, taken alone or in combination, neither disclose nor suggest the recited features and relationships. The Office has not established a *prima facie* showing of obviousness.

### **Claim 25**

Claim 25 depends from claim 24. As previously discussed, the applied references cannot be relied upon to teach or suggest removing a connecting member from a wall (claim 24). It follows that the applied references cannot be relied upon to teach or suggest the placing of medical items. It would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention.

### **Claim 26**

Claim 26 depends from claim 24. As previously discussed, the applied references cannot be relied upon to teach or suggest removing a connecting member from a wall (claim 24). It

follows that the applied references cannot be relied upon to teach or suggest installing a locking mechanism in the manner recited. That is, it would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention.

#### **Claim 27**

Claim 27 depends from claim 26. Neither of the applied references, taken alone or in combination, disclose nor suggest removing a locking mechanism. The Office has not established a *prima facie* showing of obviousness.

#### **Claim 28**

Claim 28 depends from claim 26. Neither of the applied references, taken alone or in combination, disclose nor suggest relating a predetermined input to causing a locking mechanism to provide access to a selected first medical item in the manner recited. The Office has not established a *prima facie* showing of obviousness.

#### **Claim 37**

Claim 37 depends from claim 41. Neither of the applied references, taken alone or in combination, disclose nor suggest the recited features of claim 41. For example, as previously discussed, Bach does not disclose or suggest each bracket including a tab portion adjacent each longitudinal end, and finger portions adjacent an edge (claim 41). Lipps also lacks the recited features. It follows that neither of the applied references, taken alone or in combination, can disclose or suggest that a door is moveably mounted in supporting connection with a cabinet in the manner recited in claim 37. Thus, it would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention.

### **Claim 38**

Claim 38 depends from claim 37. Neither of the applied references, taken alone or in combination, disclose or suggest a lock module in the manner recited. It would not have been obvious to one having ordinary skill in the art to have combined the references. Nor would the combined references have produced the recited invention.

### **Claim 39**

Claim 39 depends from claim 38. Neither of the applied references disclose or suggest a computer operative responsive to authorized inputs to cause the condition of a lock module to change. The alleged lock (58) in Lipps is a manual key lock (col. 4, lines 11-12; col. 6, lines 39-42). Thus, the Office has not established a *prima facie* showing of obviousness.

### **The Pending Claims Are Not Obvious (Under the Judicially Created Doctrine of Obviousness-Type Double Patenting) Over Any of the Applied Primary U.S. Patents in view of Bach**

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of (any one of nine) respective U.S. Patents in view of Bach. Appellant traverses all of these rejections.

First, the Action apparently relies on each of the primary references to teach subject matter relating to either "a computer system for a medical cabinet having drawers" or "a computer system for a medical storage area." As discussed in more detail herein, Appellant traverses the rejections based on the alleged teachings of each of the primary references.

Nevertheless, only Appellant's claim 39 recites a "computer." Thus, even if it were that each of the primary references properly teach a "computer" as alleged, then their application to Appellant's claims would be limited to claim 39.

As previously discussed, Bach fails to disclose or suggest the recited features and relationships for which it is relied upon. Each of the obviousness-type double patenting rejections relies on the alleged (but absent) features and relationships in Bach. It follows that Bach cannot alleviate the deficiencies of each of the nine primary (U.S. patent) references.

Furthermore, the alleged modification to the primary reference in each of the alleged obviousness-type double patenting rejections would destroy the disclosed and desired operability or advantage of the primary reference teaching (as claimed). *In re Fine*, supra. Thus, the rejections are improper and should be withdrawn.

Additionally, any attempt to have used Bach "in order to obtain the apparatus as described in claims 1-56" (Action pages 16-19) is clearly an attempt at hindsight reconstruction of Appellant's claimed invention. The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellant's disclosure. Such application is impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). It follows that it would not have been obvious to have modified any of the primary (U.S. patent) references in the manner alleged. It is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

Appellant submits that the Action also does not comply with the rules of the Patent Office. MPEP § 804II.B.1 provides that "any analysis employed in an obvious-type double

patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination." Additionally, "Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. § 103" (MPEP § 2141; version August 2001; page 2100-113). The Action has not properly conducted a *Graham v. John Deere Co.* analysis. For example, the Action fails to ascertain the differences between the prior patent claims and the claims in issue. None of the alleged obviousness-type double patenting rejections indicate which recited features the primary reference is lacking. Nor does the Action provide any explanation as to how the primary references would be modified. Nor does the Action identify a source of any teaching, suggestion, or motivation in the prior art "to have altered the apparatus" in the claims of the primary references to have produced the invention as claimed by Appellant. MPEP § 706.02(j). In each of the rejections the Action states to "See suggestions/motivations above", but there are none to be found.

Because the Action has not properly conducted a *Graham v. John Deere Co.* analysis, and it has not met the criteria for a *prima facie* case of obviousness, it follows that no *prima facie* case of obviousness has been presented. If the Office does not produce a *prima facie* case, then the Appellant is under no obligation to submit evidence of nonobviousness (MPEP § 2142; version August 2001; page 2100-121). That is, the Appellant is under no obligation to reply to the alleged obviousness-type double patenting rejections. Furthermore, any reply would be based on pure speculation since the rejections lack the basic necessary details for a proper obviousness-type rejection to enable a proper rebuttal.

Because the Action fails to directly apply the references to the claims in the alleged obviousness-type double patenting rejections, Appellant has been unduly burdened by the Office's attempt to force Appellant to speculate as to possible rationales for the rejections. However, the Patent Office bears the burden of citing and applying prior art in a clear manner to support any rejections made. Thus, the Action's failure to clearly identify on the record the allegedly recited features and suggestions in the applied references has been taken as an admission by the Office that the applied references do not disclose nor suggest the recited features.

Furthermore, Appellant refuses to speculate how, if at all, the applied primary U.S. patent references relate to Appellant's claims 1-56. The Action is silent concerning any discussion of the primary references in regard to the claims 1-56. As previously discussed, only one of Appellant's claims (i.e., claim 39) even recites a "computer." Appellant further respectfully requests that the rejections be withdrawn on this basis.

Furthermore, the entire disclosures of these U.S. patents may not be used as prior art, which the Action apparently attempts to do. Any availability of these patents for making an obviousness-type double patenting rejection is limited to the claimed subject matter. There is no evidence of record showing that the applied primary references even have the relied upon subject matter in their claims. To construe the intended application of these applied primary references would be pure speculation, of which Appellant declines to partake.

Where is "a computer system for a medical cabinet having drawers" or "a computer system for a medical storage area" in the relied upon claims of each of the relied upon primary

references? Furthermore, as an example showing the impropriety of all of the rejections, where is a "computer" even mentioned in claim 1 of U.S. patent 5,961,036? Appellant also asserts that many of the applied primary references are directed to method claims, whereas each of Appellant's independent claims are directed to an apparatus. As previously discussed, the Office has improperly relied on the entire disclosures of these U.S. patents instead of only their claimed subject matter. Furthermore, as previously discussed, only Appellant's claim 39 recites a "computer." Thus, Appellant further respectfully requests that the rejections be withdrawn on these basis.

As previously discussed, the Action is silent concerning any discussion of the applied primary references in regard to Appellant's claims 1-56. Thus, Appellant respectfully submits that the Office has not "fully and clearly stated" the rejection as is required by MPEP § 707.07(d). Nor did the Office "properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply" in accordance with MPEP § 706.02(j). Additionally, 37 C.F.R. § 1.104 (c) (2), regarding references, requires that "the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained." Additionally, to support a conclusion of obviousness, a convincing line of reasoning must be presented. MPEP § 706.02(j). However, Appellant respectfully submits that no line of reasoning has been presented, let alone a convincing line of reasoning. Furthermore, because the basis for the rejections have not been properly communicated, Appellant has not been given a fair opportunity to properly reply. That

is, Appellant has been left with the burden of trying to properly respond to the unclear, incomplete, and defective obviousness-type double patenting rejections.

The Action does not state in any way that is reasonably understandable by Appellant, where the specific features recited in Appellant's claims 1-56 are allegedly found in the applied art. Again, for these reasons it is respectfully submitted that the Action fails to establish a *prima facie* case of obviousness against the subject matter recited in Appellant's claims 1-56, and the rejections should be withdrawn.

Nevertheless, Appellant has reviewed the references cited and has determined that these references, either taken individually or with Bach, clearly do not teach nor suggest the features and relationships recited in Appellant's claims. Therefore, the claims directed to the present invention would not have been obvious to one having ordinary skill in the art.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellant's invention, it is respectfully submitted that the claims 1-56 are allowable for these reasons. The Action fails to establish a *prima facie* case of obviousness against any of the claims. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

#### **Additional Comments**

Appellant acknowledges that claims 49-52 were neither rejected under 35 U.S.C. § 102(b) as being anticipated by Bach, nor rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable



over Lipps in view of Bach. Thus, these claims are allowable but for the 35 U.S.C. § 112, second paragraph rejection and the obviousness-type double patenting rejections, which may be overcome by filing a terminal disclaimer.

## CONCLUSION

Each of Appellant's claims satisfy the requirements of 35 U.S.C. § 112. Also, as explained above, each of the pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellant's invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000

Reg. No. 31,029